

Remarks:

Reconsideration of the application is requested.

Claims 6, 8, 9, 10-12, and 14-25 remain in the application.

Claim 20 has been amended. Claims 15-19 have been withdrawn from consideration.

In item 3 on page 2 of the Office action, claims 6, 8, 10-12, and 20-25 have been rejected as being obvious over Boss et al. (U.S. Patent No. 6,142,353) (hereinafter "Boss") in view of Bodie et al. (U.S. Patent No. 5,518,228) (hereinafter "Bodie") under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 13, line 1 through page 15, line 10 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 20 calls for, *inter alia*:

a plurality of subassembly drives running in continuous operation, and at least some of the subassembly drives each including a controllable motor.

It is noted that at the priority date of Boss the invention according to Bodie already was the state of the art.

The Boss reference discloses a gathering stapler, having a mode of operation which corresponds to the instant application. According to this mode of operation, all of the components are continuously in operation and the components follow laws of motion which are all tuned to each other.

Despite the teaching of Bodie, Boss discloses a common drive, for which the laws of motion of the individual components are realized by using interconnected corresponding gear units.

Due to the strict mutual dependency of the sequential movements of the components in the device disclosed by Boss, the inventors deliberately avoided using respective drives with controllable motors for each of the continuously operating components, even though it was known from Bodie to provide individual components with independent drives having motors.

Therefore, for the continuously operating gathering stapler disclosed by the Boss reference, there had been prejudice toward providing a strict mechanical coupling of the individual components in order to ensure the mutual tuning of their sequential movements.

Furthermore, since the drives disclosed by Bodie are intermittently in operation at different times, and since the drives effect completely independent sequential movements of different components, the Bodie reference was not able to overcome the above-noted prejudice.

The references do not show or suggest a plurality of subassembly drives running in continuous operation, and at least some of the subassembly drives each including a controllable motor, as recited in claim 20 of the instant application.

Moreover, it is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added).

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination".

In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original).

"Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Boss to incorporate the features of Bodie, and there is no teaching or suggestion in Bodie to incorporate the features of Boss.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the

requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Boss or Bodie or to combine Boss's and Bodie's teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Boss or Bodie or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Since claim 20 is believed to be allowable, dependent claims 6, 8, 10-12, 14, and 21-25 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 20. Claim 20 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 20, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 6, 8, 9, 10-12, and 14-25 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$110 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



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